REMARKS

Claims 2, 3, 5-9, 11-16, 18-20, and 24-29 remain in this application. Claim 24 is the only independent claim. Claims 2, 3, 5-9, 11-16, 18-20, and 25-29 are dependent, either directly or indirectly, on Claim 24. Claim 24 claims Applicant's wire separator apparatus as illustrated in Fig. 1. Applicant has amended Claims 7, 8, 11, 14, 15, 19 and 24 as suggested by the Examiner in the "Response to Argument" on pages 7-10 of the Office Action to which this Amendment is responsive. Claims 18 and 27-29 have been canceled without prejudice to Applicant. Thus, Applicant, by this Amendment, has not raised any new issues. Applicant respectfully solicits the entrance of each of the amendments made.

The "Information Disclosure Statement" filed on April 5, 2004, was never intended to be an Information Disclosure Statement; and thus, has not been revised as suggested. Applicant was merely informing the Examiner of an infringement of the pending claims that is ongoing.

Reconsideration of the Examiner's objection to the Amendment filed on March 20, 2003, because it introduces new matter into the disclosure is respectfully requested. There is no disclosure in the specification that would indicate that either the linear dimensions in inches or the angular dimensions in degrees are in any way precise. Generally, they are given in language of inch increments or ten degree increments. Further, many of the dimensions are given in ranges, for example, "from 3 to 30 degrees" and "from 60 to 80 degrees." Further, the specification leads one to believe that these dimensions are not made in a laboratory or with highly precise scientific measurements inasmuch as Applicant's insulating wire separator apparatus is utilized in a construction setting to lay tracer wires when utility systems are installed.

No one would expect precise measurements in such a setting. However, in deference to the Examiner and in order to place this application clearly in form for allowance, Applicant has deleted the word "about" from the language "about 60 degrees" and "about 80 degrees" on lines 5 and 6 of the paragraph starting on page 21, line 7, from "about 3 inches" and "about 6 inches" on line 7 of the paragraph starting on page 21, line 18, and from other portions of the specification and has deleted the word "about" in Claims 7, 8, 11, 14, 15 and 19.

For the same reasons, Applicant has substituted the language utilized by the Examiner throughout the Office Action, i.e., "plate and earth anchor portion" for the language "foot plate and earth anchor portion" which the Examiner labels as new matter even though Applicant submits that it is clear from the specification that the conduit is positioned in the conduit receiving portion by placing a foot on the "plate and earth anchor." The term "foot plate" has been deleted from the specification and claims in deference to the Examiner in order to place this application clearly in form for allowance.

As amended herein, Applicant respectfully submits that all alleged new matter inserted in Applicant's response dated March 17, 2003 and filed on March 20, 2003, has been canceled.

Reconsideration of the drawings as failing to comply with 37 CFR 1.84(p)(5) because they do not include numeral 122 at line 7 on page 7, is respectfully requested. Page 7 was amended to delete numeral 122 in the Amendment responsive to the Office Action dated May 28, 2002. Thus, Applicant respectfully submits the drawings are in compliance with 37 CFR 1.84(p)(5).

Reconsideration of Claims 2, 3, 5-9, 11-16, 18-20 and 24-29 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification, is respectfully requested. All of the objected to language has been deleted from the claims.

Reconsideration of Claims 2, 6, 24, 26 and 27, rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,601,260, issued to Shinohara et al is respectfully requested. The Shinohara et al reference does not teach or suggest Applicant's invention as claimed in Claim 24:

> "24. An insulating wire separator apparatus for separating a tracer wire a safe electrically insulative distance from a main conduit in a trench prior to back-filling comprising:
>
> a) an elongated body having opposite ends, a resilient, main conduit receiving portion at one of said opposite ends having an inner radius sized to receive said main conduit therein, an opening into said main conduit receiving portion facing away from the remainder of said body and sized to flex about said main conduit, and a pair of conduit engaging sliding wedge surfaces on opposite sides of said opening which engage said main conduit to flex said main conduit receiving portion to expand said opening and position said main conduit within said main conduit receiving portion upon the application of force between said main conduit and said conduit engaging sliding wedge surfaces of said main conduit receiving portion;
>
> b) an arm portion of said body extending away from said main conduit receiving portion on a side opposite said opening, said arm portion extending to the other of said opposite ends, an electrically insulative safe distance beyond said main conduit receiving portion;
>
> c) a plate and earth anchor portion extending generally perpendicularly from said arm portion in proximity to said conduit receiving portion whereby said force may be applied between said conduit engaging sliding wedge surfaces and said main conduit to flex said main conduit receiving portion and expand said opening to position said main conduit in said main conduit receiving portion and to resist rotation of said wire separator apparatus about said main conduit after back-filling; and

d) a tracer wire clip portion for receiving a tracer wire therein, said tracer wire clip portion being positioned on said arm portion adjacent to said other end to position the tracer wire said safe distance from said main conduit receiving portion and said conduit therein to protect said conduit from being damaged."

The patent issued to Shinohara et al does not teach or suggest an insulating wire separator apparatus. In contrast, it teaches a flexible retainer, and more specifically, a coil clamp and a cable clamp having a unique anchor portion at its distal end. This unique anchor portion allows for the coil clamp 10 and cable clamp 60 to be mounted to sheet material having various thicknesses and a hole therein having various dimensions in a manner which allows the coil clamp to be inclined as illustrated in Fig. 4 and described in column 6, lines 30-40. The coil clamp 10 is used to hold degaussing coils 42 about a cathode ray tube 18. The cable clamp 60 is mounted to a mounting plate vo and an opening/closing door 72 as described in column 7, lines 20-22. Both the coil clamp 10 and the cable clamp 60 utilize the retainer of the invention to secure the coil clamp 10 and the cable clamp 60 to a plate having a hole therein through which the retaining means 30 passes and engages. The retainer 30 of the invention disclosed by Shinohara et al has four aspects:

(1) The retainer has an anchor portion at its distal end with leg bodies which extend from a main body, substantially parallel to each other with a gap between the leg bodies. The anchor portion connects the distal ends of the leg bodies and is tapered. Pawl pieces project from a base end of the anchor portion, which are passed through the mounting hole, in a direction separating from each other, the distal ends of the pawl pieces elastically abut a back surface of the mounting plate, when a force acting to pull the anchor portion out of the mounting hole acts on the pawl

pieces. The pawl pieces are pressed and expanded outwardly at a peripheral edge of the mounting hole so as to plane-contact the back surface of the mounting plate. Urging means project from the outer surface of the leg bodies distal ends upon the urging means being elastically in contact with the surface of the mounting plate. Column 1, line 66 through column 2, line 16.

(2) The urging means is formed by elastic plates, the elastic plates diagonally project from the outer surfaces of the base portion of the leg bodies in the direction of separating from each other. Intermediate portions of the elastic plates are bent. Distal end portions of the elastic plates extend toward the leg bodies so as to elastically contact the surface of the mounting plate. Column 2, line 57 to column 3, line 19.

(3) The leg bodies are retained within the mounting hole and base portions of the leg bodies are thin compared to the other areas of the leg bodies. Column 3, lines 20-23.

(4) The anchor portion retains the member to be retained on a mounting plate by engaging the retaining portion within a mounting hole formed in the mounting plate comprising a pair of leg bodies which extends from the end portion of the elongated and substantially plate shaped main body at which the retaining portion is formed in the longitudinal direction of the main body and a pair of leg bodies being substantially parallel so as to oppose each other with a gap between the leg bodies. The anchor portion connects distal ends of the pair of leg bodies which are tapered. Pawl pieces project from the base end of the anchor and pass through the mounting hole in a direction separating from each other distal ends of the pawl pieces elastically abutting the back surface of the mounting plate so that the pawl pieces gradually separate from

the main body in a longitudinal proximal end direction of the main body when the force acting to pull the anchor portion out of the mounting hole acts on the pawl pieces. The pawl pieces are pressed and expanded outwardly at the peripheral edge of the mounting hole so as to plane contact the back surface of the mounting plate. Urging means projects from the outer surfaces of the leg bodies with distal ends of the urging means being elastically contacted with the surface of the mounting plate. Column 3, lines 32-36.

Applicant's insulating wire separator includes none of these four aspects of the retainer/anchor disclosed in the Shinohara et al reference. Applicant's insulating wire separator is not mounted in a mounting hole on a plate. The Shinohara et al reference has nothing to do with spacing tracer wires from utility conduits in the ground. Applicant's invention has nothing to do with degaussing coils, cathode ray tubes and the like, and the Shinohara et al reference has nothing to do with utility cables or tracer wires buried in the ground.

Additionally, the Shinohara reference cannot be used as "an insulating wire separator apparatus for separating a tracer wire a safe electrically insulated distance from a main conduit in a trench prior to backfilling" as the retainer structure of Shinohara cannot be fastened to a main conduit. The Shinohara reference has no main conduit receiving portion "at one of said opposite ends" nor a "tracer wire clip portion for receiving a tracer wire therein * * * adjacent to said other end to position the tracer wire said safe distance from said main conduit receiving portion," no matter how the Examiner interprets the Shinohara reference. As the Examiner stated "recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." The Shinohara reference is not such prior art.

In order to anticipate Applicant's claims, Shinohara et al must be read to include all material elements of a claim. *In re Marshall* (CCPA 1978) 577 F.2d 301, 198 USPQ 344, *In re Kalm* (CCPA 1967) 378 F.2d 959, 154 USPQ 10, which must be enabling to one skilled in the art. The Examiner reads Shinohara et al on Applicant's claims at page 4 of the Office Action to which this Amendment is responsive, inconsistently, inaccurately, and erroneously. The Examiner states, utilizing the language of Claim 24, "Shinohara discloses a wire support (Fig. 2) made or resin comprising: an elongated body (10 generally) having opposite ends, a resilient main conduit receiving portion (41 adjacent 14) at one end of the body (*wherein the two "conduit receiving portions 41" are both spaced from the opposite ends by either the transverse groove portion 14 and a substantial length of the body or the entire anchor portion 30*) having an inner radius sized to receive a conduit and a pair of conduit engaging sliding wedge surfaces (surfaces of 50 and 52 defining the opening/gap therebetween) on opposite sides of an opening (between 50 and 54A) (*overlooking the differences between degaussing coils which are multiple and flexible and utility conduits which are single and relatively rigid*); an I-beam portion (extending between 20 and 14) extending away from the main conduit receiving portion (41 adjacent 14) on the side opposite the opening (between 50 and 54A) and extending to the opposite end of the elongated body a distance beyond the main conduit receiving portion (*the I-beam portion actually extends on opposite sides of the "conduit receiving portion"*); a plate and anchor portion (46 located between 41 and 52) extending generally perpendicularly from the arm

portion in proximity to the conduit receiving portion (41 adjacent 14) (*the anchor portion 46 prevents the body from rotating about its own longitudinal axis whereas Applicant's anchor prevents the body from rotating about the conduit axis*) a wire clip portion (41 adjacent 12) having a pair of fingers 50, 52 (*the Examiner's wire clip portion is identical to the Examiner's conduit receiving portion whereas Applicant's wire clip portion and conduit receiving portion are vastly different)* and positioned adjacent to the opposite end of the elongated body) (*the Examiner's wire clip portion and conduit receiving portion are both intermediate the opposite ends of the elongated body 10, whereas Applicant's conduit receiving portion is at one end and the wire clip portion is at the other end, the Examiner's wire clip portion is not positioned adjacent the opposite end of the elongated body. It is intermediate of the ends as is the Examiner's conduit receiving portion; Applicant makes a difference between the use of the words "at one end of the body" and "adjacent to the opposite end of the elongated body;" the Examiner equates "adjacent to" as being "at" the end*); and a separator post 30, 40 extending generally perpendicularly from the arm portion and spaced from the plate portion but in proximity to the wire clip portion, the arm portion extending beyond the separator post (30, 40) (*the Examiner, not finding anything corresponding to Applicant's separator post refers to the structure of the retainer 30 by which the Shinohara et al retainer is secured within an opening in the mounting plate*). This retainer 30 (the Examiner's separator post) is at one end of the body 12, not midway between and spaced from both ends of Applicant's body.

The Examiner has both (1) misapplied Shinohara et al to Applicant's claims as the Shinohara et al patent discloses a retainer in a technology far different from the technology

relating to Applicant's insulating wire separator, and (2) applied that reference to Applicant's claims inappropriately. The Examiner (1) cannot ignore the difference in the technology between the Shinohara et al retainer and Applicant's insulating wire separator apparatus, (2) cannot ignore the clear meaning of the claim language by interpreting the words "at said end" to include the clamp plates 41 which are disclosed in Shinohara et al which are spaced from end 14 by the groove portions 14, and (3) cannot interpret the words "adjacent said end" to mean midway between the ends, where the Shinohara et al reference clearly discloses the two arc-shaped clamp plates 41 to be positioned. Lastly, a person skilled in the art of Applicant's invention would never look to the Shinohara et al reference for any teaching, guidance, or information with regard to utility tracer wire separators as separate turns of degaussing coils require low voltage insulation whereas the insulation between conduits and tracer wires must be sufficient to withstand lighting strikes.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single reference (citations omitted). The identical invention must be shown in as complete detail as contained in the . . . claim (citations omitted). The elements must be arranged as required by the claim. MPEP § 2131.

Contrary to the Examiner's statement that all of the elements of Claim 24 are disclosed, taught or suggested in the Shinohara et al reference, the following elements are not disclosed, taught or suggested:

> (a) "an elongated body having opposite ends, a resilient main conduit receiving portion at one of said opposite ends having an inner radius sized to receive said main conduit therein, an opening

into said main conduit receiving portion facing away from the remainder of said body and sized to flex about said main conduit, and a pair of conduit engaging sliding wedge surfaces on opposite sides of said opening which engage said main conduit to flex said main conduit receiving portion to expand said opening and position said main conduit within said main conduit receiving portion upon the application of force between said main conduit and said conduit engaging sliding wedge surfaces of said main conduit receiving portion;

(c) a plate and earth anchor portion extending generally perpendicularly from said arm portion in proximity to said conduit receiving portion whereby said force may be applied between said conduit engaging sliding wedge surfaces and said main conduit to flex said main conduit receiving portion and expand said opening to position said main conduit in said main conduit receiving portion and to resist rotation of said wire separator apparatus about said main conduit after back-filling;

d) a tracer wire clip portion for receiving a tracer wire therein, said tracer wire clip portion being positioned on said arm portion adjacent to said other end to position the tracer wire said safe distance from said main conduit receiving portion and said conduit therein to protect said conduit from being damaged."

are not taught, suggested or disclosed in the Shinohara et al reference, and the rejection of Claim 24 under 102(b) is totally unsupported by the reference, and should be withdrawn.

Claim 2 is dependent upon Claim 24. Thus, Claim 2 includes all of the language of Claim 24 and is submitted to be allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 2 further requires:

"the insulating wire separator apparatus is made of a resilient, nonconductive, noncorrosive, nonbiodegradable material."

The Shinohara et al reference does not disclose the material from which the Shinohara et al retainer is made. Thus, there is nothing in the Shinohara et al reference that would teach, suggest or disclose or even require "a noncorrosive, nonbiodegradable material."

Claim 6 is dependent upon Claim 24. Thus, Claim 6 includes all of the language of Claim 24 and is submitted to be allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 6 further requires:

> "the tracer wire clip portion is located at said other end of said arm portion."

The Shinohara et al reference does not teach, suggest or disclose a "main conduit receiving portion" at one end of the arm and a "tracer wire clip portion * * * adjacent to said other end" of said arm.

Claim 26 is dependent upon Claim 24. Claim 26 thus includes all of the language of Claim 24 and is submitted to be allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 26 further requires:

> "said tracer wire clip portion has a pair of fingers for receiving a tracer wire therebetween."

Reconsideration of Claims 3, 5, 7, 8, 11, 19, 20, 28, and 29, rejected under 35 U.S.C. §103(a) as being unpatentable over Shinohara et al is also respectfully requested.

To make a *prima facie* case for obviousness under 35 U.S.C. § 103, the Examiner must show: (1) some suggestion or motivation in the prior art reference(s) or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings to meet the claimed invention; (2) a reasonable expectation of success for the

modification or combination of the prior art references; and (3) the prior art references teach or suggest all of the claim limitations of the claimed invention. MPEP § 2143.

The mere fact that references *can be* combined does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination MPEP § 2143.01. Citing references which merely indicate that isolated elements and/or features recited in the claims are individually known in the art or that the elements would have been well within the ordinary skill of the art at the time the invention was made is not a sufficient basis for concluding that the combination of claimed elements would have been obvious, absent objective evidence of a motivating force which would compel persons skilled in the art to do what Applicant has done. *See Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993); *Ex parte Hiyamizu*, 10 U.S.P.Q. 2d 1393 (Bd. App. & Inter. 1988). A combination is improper where an Examiner's proposed modification would render the prior art version unsatisfactory for its intended purposes. *See Ex parte Rosenfield*, 130 U.S.P.Q. 113 (Bd. Pat. App. 1961).

An obviousness rejection is valid only if (i) it would have been obvious to a person of ordinary skill in the art to modify the structure that the primary reference discloses to that structure which is claimed, as a matter of standard design technique if the reference stands alone or as a result of a combination of one or more secondary references if the primary reference teachings are missing from the primary reference; (ii) any modification or combination is motivated or suggested by the primary reference; (iii) each and every limitation is taught by the modified or combined prior art; and (iv) such modifications or combinations do not require an inventive step.

As mentioned above, the Shinohara et al reference does not teach or suggest or disclose:

> (a) "an elongated body having opposite ends, a resilient main conduit receiving portion at one of said opposite ends having an inner radius sized to receive said main conduit therein, an opening into said main conduit receiving portion facing away from the remainder of said body and sized to flex about said main conduit, and a pair of conduit engaging sliding wedge surfaces on opposite sides of said opening which engage said main conduit to flex said main conduit receiving portion to expand said opening and position said main conduit within said main conduit receiving portion upon the application of force between said main conduit and said conduit engaging sliding wedge surfaces of said main conduit receiving portion;
>
> (c) a plate and earth anchor portion extending generally perpendicularly from said arm portion in proximity to said conduit receiving portion whereby said force may be applied between said conduit engaging sliding wedge surfaces and said main conduit to flex said main conduit receiving portion and expand said opening to position said main conduit in said main conduit receiving portion and to resist rotation of said wire separator apparatus about said main conduit after back-filling;
>
> d) a tracer wire clip portion for receiving a tracer wire therein, said tracer wire clip portion being positioned on said arm portion adjacent to said other end to position the tracer wire said safe distance from said main conduit receiving portion and said conduit therein to protect said conduit from being damaged."

These elements of Applicant's insulating wire separator apparatus are not rendered obvious by the Shinohara et al reference.

Claims 3, 5, 7, 8, 11, 19, 20 and 28 are each directly dependent on Claim 24. Thus, each of these claims include all of the language of Claim 24 and are allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 3 further requires:

> "a separator post extends at right angles from said arm portion, said separator post spaced at least ten inches from said plate portion; and said arm portion extends at least two inches beyond said separator post, to provide safe spacing for additional underground utilities in a common trench location."

The spacing of the separator post from the plate portion and the length of the arm portion are both chosen by Applicant in view of the electrical conductivity of moist soil and the environment in which Applicant's insulating wire separator is buried.

The Shinohara et al reference does not teach a separator post. Applicant's separator post extends at right angles from the arm portion between opposite ends of said body. Applicant's separator post is at least 10 inches from the plate portion and at least two inches from an end of the arm portion. No such structure is shown in Shinohara et al. The Examiner refers to a separator post 30 which is located at the distal end of the Shinohara et al retainer. The patent issued to Shinohara et al refers to an anchor portion which bears no resemblance to Applicant's separator post. The limitation "at least 10 inches from said plate portion; and said arm portion extends at least 2 inches beyond said separator post" positions the separator post between the opposite ends of Applicant's arm. Applicant's separator post bears no resemblance whatsoever to the Shinohara et al retainer 30, 40 in structure or location as argued by the Examiner. Additionally, the entire concept of separating water utilities, gas utilities, electrical utilities, or the like by a separator post is non-existent in Shinohara et al. Shinohara et al only teaches two spaced apart clamps defining a retaining space 44, neither of which bears any resemblance to any separator post.

Claim 5 is dependent upon Claim 24. Thus Claim 5 includes all of the language of Claim 24. Claim 5 is believed allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 20 is dependent upon Claim 26. Thus Claim 20 includes all of the language of Claims 24 and 26. Claim 20 is submitted to be allowable for the same reasons as reiterated herein with regard to Claims 24 and 26. Both Claims 5 and Claim 20 further require:

"said body is color coded, with a separate color used for each."

The Examiner readily admits that the Shinohara reference does not disclose any wire support being color coded. The Examiner however believes that the color coating of Applicant's separator apparatus would have been obvious to anyone of ordinary skill in the art because one would have been motivated to provide a device that is aesthetically pleasing in appearance. The aesthetic appearance of Applicant's wire separator apparatus is not a feature of Applicant's wire separator apparatus and at the construction site would be the subject of humorous jokes. Applicant's wire separator apparatus is utilized at construction sites to separate tracer wires from utility conduits. Applicant's wire separator apparatus is only "color coded" to distinguish to those having an interest between electrical conduits, water conduits, gas conduits or other utility conduits. There is no teaching in any of the references cited or applied by the Examiner of color coating any wire support to distinguish such utility conduits, nor is it obvious to do so.

Claim 7 is dependent upon Claim 24. Thus Claim 7 includes all of the language of Claim 24. Claim 7 is submitted to be allowable for the same reasons as reiterated herein above with regard to Claim 24. Claim 7 further requires:

> "the opening in the resilient, main conduit receiving portion is from sixty to eighty degrees from the centerline of the main conduit."

Again the Examiner acknowledges that the Shinohara reference does not disclose, teach or suggest the opening of Applicant's main conduit being from sixty to eighty degrees from the centerline of the main conduit. Instead, the Examiner rejects the claims as being obvious to one skilled in the art at the time the invention was made as it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

However, Applicant's insulating wire separator apparatus includes "a main conduit receiving portion sized to receive said main conduit therein", "an opening", "a pair of conduit engaging sliding wedge surfaces on the opposite sides of said opening which engage said main conduit deflects the main conduit receiving portion to expand said opening and position said main conduit within said main conduit receiving portion upon the application of force between the main conduit and said conduit engaging sliding wedge surfaces of said main conduit receiving portion." Thus, the size of the opening, the amount of force applied between the opening and the conduit, the frictional sliding wedge surfaces on opposite sides of the conduit each must be adjusted to find the optimum to allow the conduit to be positioned in Applicant's conduit receiving portion. While it arguably may be obvious to of ordinary skill in the art to adjust a single parameter to discover the optimum or workable range within the routine skill in the art, here there are too many interacting variables and that must be taken into consideration to support an obvious rejection.

The size of the opening, the friction between the conduit and the sliding surfaces, the size of the main conduit receiving portion, amount of force a 150 pound installer versus a 250 pound installer can place between the sliding surfaces and the conduit, the materials from which Applicant's wire separator apparatus is made, and the conditions of the earth surrounding the trench in which Applicant's separator apparatus is being installed all impact on the optimization of Applicant's opening. Installing Applicant's wire separator apparatus in moist clay is far different from installing Applicant's separator apparatus in dry sand or in other conditions. Applicant's choice from 60 degrees to about 80 degrees from the center line of the main conduit clearly amounts to an invention.

Similarly, with regard to Claims 8 and 19 Applicant's angling of Applicant's tracer wire clip finger portion" amounts to invention. Claim 8 is dependent upon Claim 24. Thus, Claim 8 includes all of the language of Claim 24. Claim 8 is submitted to be allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 19 is dependent upon Claim 26. Thus Claim 19 includes all of the language of Claim 24 and 26. Claim 19 is submitted to be allowable for the same reasons as reiterated herein with regard to Claims 24 and 26. Claims 8 and 19 each further require:

> "the tracer wire clip finger portion is angled from three to thirty degrees from the centerline of said arm portion to engage varying sizes of tracer wire therein."

The angling of the finger portions include the same multiple variables above mentioned with regard to Applicant's conduit receiving portion and the limitations of Claims 7 and 28 plus the additional factor that the tracer wires are utilized in varying sizes. Thus, the determination of the

angle of the finger portion accomplished by Applicant results in invention and is not the result of routine skill in the art.

Reconsideration of Claim 9, rejected under 35 U.S.C. §103 as being unpatenable over Shinohara et al in view of Adams is respectfully requested. Claim 9 is dependent on Claim 24. Thus, Claim 9 includes all of the language of Claim 24 and is respectfully submitted to be allowable for the same reasons as reiterated hereinabove with regard to Claim 24. Claim 9 further requires:

> "the main conduit receiving portion comprises an inner radius having a first half portion with a second half portion releasably secured to said first half portion by a releasable fastener."

The Examiner admits that the Shinohara et al reference does not teach or suggest Applicant's main conduit receiving portion having an inner radius with a first half portion and a second half portion releasably secured to the first half portion by a releasable fastener. There is in fact in the Shinohara et al reference no disclosure of an inner radius with a first half portion and a second half portion releasably secured together. The Adams mounting clip has no conduit receiving portion at all and thus does not add anything to the Shinohara et al reference. Adams relates to a light holder for Christmas tree lights which are relatively light weight and not to a holder for a utility conduit which are generally metal or plastic pipe in a construction setting. The Adams barbs 142 and the Adams toggles 137 are not in any way like Applicant's flange portions 211-216 and the threaded fasteners 217 and 218. No person skilled in the art to which Applicant's invention pertains would look to Adams or be motivated by Adams to do anything to the Shinohara et al coil clamp or cable clamp or to Applicant's wire separator apparatus.

The mere fact the Examiner thought he had to rely upon Adams to reject Claim 9 indicates that Claim 9 is indeed patentable over the Shinohara et al reference. Since Adams adds nothing to the Shinohara et al reference Claim 9 should be allowable for the reasons above given.

Reconsideration of Claims 12-15 and 25, rejected under 35 U.S.C. §103(a) as being unpatentable over Shinohara et al in view of the patent issued to Ziu, is respectfully requested. The mere fact that the Examiner rejects Claims 12-15 and 25 as being unpatentable over both the Shinohara et al and Ziu references indicates that the similar claims not dependent from Claim 25, i.e., Claims 5-8, 20, 26 and 28, are indeed patentable over the patent issued to Shinohara et al. The addition of the patent issued to Ziu does not add anything to the disclosure of Shinohara.

Claim 25 further requires an outwardly extending strengthening rib between the conduit engaging sliding surfaces and said arm. The patent issued to Ziu discloses a double containment height assembly. What the Examiner believes is a strengthening rib (called a "flange 40" in Ziu) is clearly not the strengthening rib Applicant is claiming. The support clip 16 has, like Applicant's main conduit receiving portion, sliding wedge surfaces. However, the strengthening rib of Ziu does not extend "between the conduit engaging sliding wedge surfaces and said arm portion" - in fact, it is spaced apart from "said conduit engaging sliding wedge surfaces." It would have been totally unclear to anyone skilled in the art how the strengthening rib 40 of Ziu would apply to Applicant's insulating wire apparatus as claimed in Claim 25 or Claims 12-15 depending therefrom.

Claims 12-15 are each dependent upon Claim 25. Claim 25 itself is dependent upon Claim 24. Thus, Claims 12-15 each include all of the language of Claims 25 and 24. Applicant

respectfully submits that Claims 12-15 and allowable for the same reasons as reiterated herein with regard to Claims 24 and 25. Claim 25 is dependent upon Claim 24 and thus includes all of the language of Claim 24. Claim 25 is respectfully submitted to be allowable for the same reasons reiterated hereinabove with regard to Claim 24. Claim 12 further requires:

> "said body is color-coded with a separate color used for each utility."

Claim 13 further requires:

> "the tracer wire clip portion is located at said other of said opposite ends."

Claim 14 further requires:

> "the opening provided in the resilient, main conduit receiving portion is from sixty to eighty degrees from the centerline of the main conduit.

Claim 15 further requires:

> "the tracer wire clip finger portion is angled from three to thirty degrees from the centerline of said arm portion to engage varying sizes of tracer wire therein."

Claim 25 further requires:

> "said main conduit receiving portion has an outwardly extending strengthening rib which extends between said conduit engaging sliding wedge surfaces and said arm portion."

The patent issued to Ziu adds nothing to this discussion.

Reconsideration of Claim 16, rejected under 35 U.S.C. §103 as being unpatentable over Shinohara et al in view of Ziu and further in view of Adams, is respectfully requested. Claim 16

is dependent upon Claim 25. Thus, Claim 16 includes all of the language of Claims 24 and 25. Claim 16 further requires:

> "the main conduit receiving portion comprises an inner radius having a first half radiused portion, with a second half radiused portion releasably secured to said first half radiused portion by a releasable fastener."

Claim 16 is submitted to be allowable for the same reasons as reiterated hereinabove with regard to Claims 24, 25 and Claim 9.

For all of the reasons above stated, Applicant respectfully submits that all of the claims presently in the application, as amended, patentably distinguish Applicant's insulating wire separator apparatus from each of the references cited and applied by the Examiner, whether taken alone or in combination with each other. Applicant respectfully solicits the prompt issuance of a Notice of Allowance.

Respectfully submitted,

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